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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,485	02/10/2004	Seiichi Katano	49987-1002	3224
29989 7590 01/18/2007 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110			EXAMINER AHUJA, SUPRIYA	
			ART UNIT	PAPER NUMBER
			2112	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/18/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/776,485

Applicant(s)

KATANO, SEIICHI

Examiner

Supriya Ahuja

Art Unit

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/26/06, 11/07/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

On page 1, [0001], line 2 of the specification, the blank should be replaced by the appropriate related U.S. patent application Ser. No.

On page 5, [0056], line 19 of the specification, the word “than” should be replaced by --that--.

Appropriate correction is required.

Claim Objections

2. **Claims 1-5, 10 and 12-14** are objected to because of the following informalities:

In claim 1, line 5, the phrase “that one or more” should be replaced by --that the one or more--.

In claim 2-5, line 2, the phrase “that one or more” should be replaced by --that the one or more--.

In claim 10, line 2, the phrase “one or more instructions” should be replaced by --one or more unauthorized instructions--.

In claim 12-14, line 3, the phrase “the storage” should be replaced by --storage--.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent

Art Unit: 2112

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claims 1-15** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12, 16-26 of U.S. Co-pending Application No. 10776486.
5. **Claim 1** discloses all limitations of claim 12 in the Co-pending Application No. 10776486 except that the one or more unauthorized instructions have been stored on the MFP. The general concept of data being stored on the MFP in order to be examined is well known in the art as an obvious storing technique and is an intrinsic property of the multi-function peripheral.
6. **Claim 2** discloses all limitations of claim 16 in the Co-pending Application No. 10776486 except that the data stored on the MFP has been modified in an unauthorized manner according to specified configuration criteria. The general concept of data being modified in an unauthorized manner is well known in the art as an obvious tampering of the data by the one or more unauthorized

instructions. It would have been inherently obvious to one of ordinary skill in the art at the time of the invention to modify U.S. Co-pending Application No. 11319255 to store data on the MFP in order to detect if the unauthorized modification of data took place, because of the one or more unauthorized instructions being stored on the MFP.

7. **Claim 3** discloses all limitations of claim 16 in the Co-pending Application No. 10776486 except to detect modification of one or more data files stored on the MFP by the one or more unauthorized instructions. The general concept of data files being modified in an MFP by one or more unauthorized instructions is well known in the art as an obvious tampering of the data files by the virus. It is an intrinsic tampering property of the one or more unauthorized instructions to behave in such a manner.
8. **Claim 4** discloses all limitations of claim 16 in the Co-pending Application No. 10776486 except to detect modification of program code stored on the MFP by the one or more unauthorized instructions. The general concept of program code being modified in an MFP by one or more unauthorized instructions is well known in the art as an obvious tampering of the program code by the virus. It is an intrinsic tampering property of the one or more unauthorized instructions to behave in such a manner.
9. **Claim 5** discloses all limitations of claim 16 in the Co-pending Application No. 10776486 except to detect modification of configuration data stored on the MFP by the one or more unauthorized instructions. The general concept of program code being modified in an MFP by one or more unauthorized instructions is well

known in the art as an obvious tampering of the configuration data by the virus. It is an intrinsic tampering property of the one or more unauthorized instructions to behave in such a manner.

10. **Claim 6-15** discloses all limitations of claims 17-26 in the Co-pending Application No. 10776486.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claims 1-15** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In independent claim 1, a “virus protection process” is being recited; however, it appears that the system would reasonably be interpreted by one of ordinary skill in the art as software, per se. A virus protection process can be considered software like anti-virus software as such claim 1 is classified as functional descriptive material. In addition, on page 2, [0032] line 3-14, the specification clearly states that the virus protection tool may be implemented in hardware, computer software, or any combination thereof, where the virus protection tool is implemented as a software process.

Therefore, dependent claims 2-16 are rejected under 35 U.S.C. 101 for the same and do not add any tangible result to the claim.

Art Unit: 2112

13. **Claim 15** is also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 is drawn towards the MFP receiving the data over a network. In this instance, the data is received over a network as evident by the disclosure of page 6 [0065] of the specification, which can be in the form of wireless network or electromagnetic signals or carrier waves. The scope of the claim encompasses using an electromagnetic signal or carrier wave as a medium. Therefore, dependent claim 15 is also rejected under 35 U.S.C. 101, as it does not add any tangible results to the claim.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. **Claims 1-7, 11, 15** are rejected under 35 U.S.C. 102(b) as being anticipated by Walsh et al. (US 5,956,481 dated 09/21/1999).

Claim 1. Walsh et al. discloses a multi-function peripheral device (computer system, see abstract line 1. The computer system is treated as a multi-function peripheral, as it may include other devices like scanner, printer, speakers, etc. (col. 8, lines 41 – 53)) comprising: a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) configured to detect that one or more unauthorized instructions (virus, abstract

line 8) have been stored on the multi-function peripheral (see abstract lines 7-8); and in response to detecting that one or more unauthorized instructions have been stored on the multi-function peripheral, perform one or more actions (notice offers options, col. 3 lines 59-62) to address the one or more unauthorized instructions that have been stored on the multi-function peripheral.

Claim 2. Walsh et al. discloses a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) configured to detect that one or more unauthorized instructions (virus, abstract line 8) have been stored on the multi-function peripheral by periodically examining, according to specified configuration criteria (customization routines, see Fig. 4B, col. 12 lines 2-25), data stored on the multi-function peripheral to determine whether the data has been modified in an unauthorized manner (unintended or unexpected manner, col. 1, lines 30 – 39).

Claim 3. Walsh et al. discloses a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) is configured to detect that one or more unauthorized instructions (virus, abstract line 8) have been stored on the multi-function peripheral by examining and detecting that one or more data files (data files, abstract line 1) stored on the multi-function peripheral have been modified (col. 1 lines 30-39).

Claim 4. Walsh et al. discloses a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) is configured to detect that one or more unauthorized instructions (virus, abstract line 8) have been stored on the multi-function peripheral by examining

and detecting that program code (executable program, col. 1 lines 32- 36, col. 8 lines 34-40) stored on the multi-function peripheral has been modified (col. 1 lines 30-39).

Claim 5. Walsh et al. discloses a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) is configured to detect that one or more unauthorized instructions (virus, abstract line 8) have been stored on the multi-function peripheral by examining and detecting that configuration data (data files, abstract line 1) stored on the multi-function peripheral has been modified (col. 1 lines 30-39).

Claim 6. Walsh et al. discloses a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) is configured to examine data stored (col. 8 lines 1-6) on a non-volatile memory (non-volatile storage, col. 8 lines 24-26) of the multi-function peripheral.

Claim 7. Walsh et al. discloses a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) configured to examine data stored (col. 8 lines 1-6) in a volatile (RAM, col. 8 lines 34-40) memory of the multi-function peripheral.

Claim 11. Walsh et al. discloses a virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) configured to notify a user via a graphical user interface (computer monitor, col. 3 lines 21 – 25, 35-40) on the multi-function peripheral that the storage of the one or more unauthorized instructions (virus, abstract line 8) on the multi-function peripheral has been detected.

Claim 15. Walsh et al. discloses a multi-function peripheral (computer system, see abstract line 1. The computer system is treated as a multi-function peripheral, as it may include other devices like scanner, printer, speakers, etc. (col. 8, lines 41 – 53)) configured to receive, over a network (col. 8 lines 54-67 and col. 9 lines 1-12), data (col. 8 lines 1-6) used by the virus protection process (virus protection system implemented as utility programs, see abstract line 2 and col. 1 lines 40 - 45) to detect that the one or more unauthorized instructions (virus, abstract line 8) have been stored on the multi-function peripheral.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 8-10 and 12-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. as applied to claim 1 above, and further in view of Boldon et al. (U.S. 2003/0048468, dated 03/13/2003)

Boldon et al. teaches virus filtering of peripherals but not limited to printers, scanners, facsimile machines or the like (abstract, lines 1-4). Boldon et al. describes a method whereby embedded peripheral devices may be able to detect and otherwise render harmless any such virus that is received by the device (page 2 [0017]), as required by **claim 10**. Moreover, Boldon et al. discloses the step of

deleting the information if the information contains a virus and/or contacting the system administrator if a virus is found in the information (page 1 [0007]).

Claims 8. Walsh et al. discloses all the limitations of claims 8 except for a virus protection process configured to undo changes made as a result of execution of the one or more unauthorized instructions. The general concept of using anti-virus software to undo changes made by the virus is well known in the art as illustrated by Chen et al. (U.S. 5,832,208, dated 11/03/1998). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walsh et al. to include the use of a virus curing procedure as taught by Chen et al. (Fig. 3, col. 8 lines 6-15) in order to fix the files and continue normal functioning of all the files and programs.

Claim 9. Walsh et al discloses all the limitations of claim 9 except for a virus protection process configured to determination of restoring virus infected data to a prior state; and if not able to restore, deleting the particular data from the multi-function peripheral. The general concept of using an anti-virus software to return to the prior state and if not able to restore changes made by the virus, deleting the virus is well known in the art as illustrated by Chen et al. (U.S. 5,832,208, dated 11/03/1998). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Walsh et al. to include the use of a virus curing and deletion procedure as taught by Chen et al. (col. 7 lines 65 – 67 and col. 8 lines 6 – 15) in order continue normal functioning of all the files and programs.

Claims 12-14. Walsh et al. discloses a virus protections system, which detects prior to opening of a file, whether the file contains a virus or not (abstract). The

Art Unit: 2112

virus protection system provides a notice or a warning message in response to detecting the opening of a document that may contain a virus (col. 9 lines 60 –65). The notice is presented on a display screen on a monitor and can be presented in alternative formats via other output devices, such a printers or loud speakers (col. 10 lines 12- 16). Walsh et al. discloses all the limitations of claims 12-14 except for presenting the data in the form of an email or fax or a printout. Therefore, it would have been an obvious delivery technique to one of ordinary skill of art at the time of inventions to modify Walsh et al. to include the use of presenting data in the form of a fax or an email or a printout on a network in order to send the notifications in any format as suitable to the user faster.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Supriya Ahuja whose telephone number is 571-270-1588. The examiner can normally be reached on Monday - Thursday 7:30 -5:00; 2nd Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on 571-272-1808. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

Art Unit: 2112

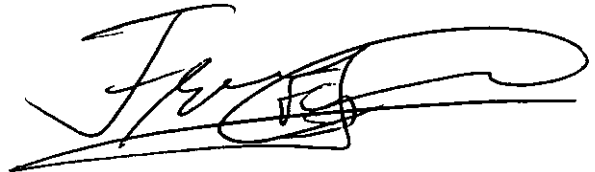
more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Supriya Ahuja

S.A.

January 5, 2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Frantz', with a large, sweeping horizontal stroke underneath.